

REMARKS

Claims 16 and 21–31 are pending with claims 17–20 being canceled and claim 31 being added.

Claim Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 16, 26 and 30 have been amended to delete the term “mean.” Consequently, applicants submit that these rejections should be withdrawn. However, applicants respectfully assert that one of ordinary skill in the art would understand the meaning of this particle size range, pursuant to their comments in the reply filed 22 September 2003.

Claim Rejections Under 35 U.S.C. § 102

Claims 16–19, 21, 23, 24 and 28–30 stand rejected as allegedly being anticipated by JP 46-026406 (JP). Applicants respectfully submit that claim 16 now includes the substantive features of claim 20 and claim 29 now depends from claim 16. Consequently, applicants respectfully submit that these rejections should be withdrawn.

Claim Rejections Under 35 U.S.C. § 103

Claim 20 stands rejected as allegedly being unpatentable over JP. Applicants respectfully traverse this rejection as applicable to the present claims.

Particularly, not only does JP fail to teach or suggest a mixture of different inorganic platelet-form substrates comprising mica, a pearl luster pigment, and an electrically-conductive pigment, it fails to teach an electrically-conductive pigment. Particularly, applicants traverse the assertion that titanium dioxide reads on “electrically-conductive pigment.” Rather, titanium dioxide is used as a filler or white pigment in paints; in cosmetic formulations, such as lipsticks, body powders, makeups, and soaps; toothpaste; and the like. It is not an electrically-conductive pigment at all. Typically, electrically-conductive pigments

are coated with compounds such as SbO_2 or SnO_2 . Consequently, applicants respectfully submit that these rejections should be withdrawn.

Claims 16–21, 23, 24, and 26–28 stand rejected over JP in view of U.S. Patent No. 4,740,269 (Berger). First, although Berger discloses a process for contacting a paper with laser radiation to form authenticating marks, it fails to cure deficiencies in the JP, because it fails to suggest those elements lacking in the JP as discussed above. Moreover, there is insufficient motivation to combine these references. Particularly, JP gives no indication that its paper is suitable for laser marking. At page 7 of the translation, JP touts its paper as having an excellent affinity for printing ink and improved printing characteristics. This is further reinforced in the last sentences of Examples 1–3 at pages 7–9 of the specification. Consequently, applicants respectfully submit that there is insufficient motivation to combine these references to laser mark the paper of JP.

Additionally, even if these references allegedly are combinable, there is no teaching or suggestion that the alleged combination would provide an absorber material having a pale intrinsic color (relevant to claim 26). Consequently, applicants respectfully submit that these rejections should be withdrawn.

Claims 16–23, 24, 27 and 28 stand rejected as allegedly being unpatentable over JP in view of U.S. Patent No. 3,770,577 (Humphrey). Applicants respectfully traverse these rejections.

First, applicants respectfully submit that the citation of Humphrey fails to cure the deficiencies of JP, as it also fails to suggest the missing elements discussed above. Moreover, applicants respectfully submit that there is insufficient motivation to combine these references. Humphrey pertains to compositions used as fire retardants. There is no desirability provided in JP to include a fire retardant composition in its paper. Rather, JP merely discloses a paper for printing. In marked contrast, a fire retardant composition would desirably be incorporated into a paper or paper board used in such products as insulation,

which use is not taught in the JP. See column 2, lines 50–56 of Humphrey. Consequently, applicants respectfully submit that these rejections should be withdrawn.

Claim 25 stands rejected as allegedly being unpatentable over U.S. Patent No. 5,897,938 (Shinmoto) in view of U.S. Patent No. 6,019,831 (Schmidt). Applicants respectfully traverse this rejection.

Even if the references are allegedly combinable, the combined teachings fail to teach or suggest an absorber coating of a thickness suitable for laser marking having a pale intrinsic color. Rather, Schmidt discloses pigments having a high color intensity and high hiding power. See column 4, lines 20–29 of Schmidt. These pigments would be inappropriate for marking paper because in such an application the absorber should have a very pale, neutral intrinsic color. Consequently, the alleged combination fails to teach or suggest the present invention.

In view of the above, applicants respectfully request favorable reconsideration. If there are any remaining issues which can be expedited by a telephone conference, the Examiner is courteously invited to telephone counsel at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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Attorney Docket No.: MERCK-2009

Date: August 9, 2004

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